

Claim 5 has been amended to delete the word "essentially."

A typographical or clerical error has been corrected in Claim 6. This amendment is not intended to change the scope of what was originally intended for this Claim.

Minor clarifications have been made to Claim 9, clarifications that are intended to improve the "readability" of the Claim. No actual errors are being corrected, and there is no intention to change the scope of this Claim.

Claims 15-22 have been amended to convert what were originally product Claims into process Claims having otherwise similar limitations. Other than those changes that were appropriate to effect the conversion of product claims to process claims, no other changes in the scope of these Claims are intended.

Basis for new Claims 23 and 24 is found throughout the specification, including for example paragraphs [0028] through [0031], and [0059].

Basis for new Claims 25 and 26 includes, for example, the specification at paragraphs [0004], [0023], and [0060].

Basis for new Claims 27 and 28 includes, for example, the specification at paragraphs [0004] and [0054].

Basis for new Claims 29-31 includes, for example, the specification at paragraphs [0005], [0027], [0056], [0057], and [0060].

Basis for new Claims 32-33 includes, for example, the specification at paragraphs [0004], [0023], and [0060].

The enclosed check for \$210 includes: **(a)** the \$60 fee to extend the time for response to the December 16, 2004 Office Action for one month, from March 16, 2005 to April 18, 2005; and **(b)** the \$150 fee for the 6 additional Claims added by this amendment; both paid as a small entity. If this amount is incorrect, please refer to the Deposit Account Authorization previously filed for this application. If any additional extension of time is required, please consider this paper a petition for the total extension of time required.

Reexamination and reconsideration of the application, as amended, are respectfully requested.

The Enablement Rejection Pertaining to the ATCC Deposit

Claims 1-22 were rejected under 35 U.S.C. § 112, first paragraph as lacking an enabling disclosure, on the ground that it was said not to be apparent that the existing deposit of 'Cheniere' seeds with the American Type Culture Collection had satisfied the requirements of 37 C.F.R. § 1.801 through 1.809.

This ground of rejection is not understood. The Office's attention is respectfully directed to paragraph [0061] of the specification. Also, please see Appendix B, which is a copy of the November 10, 2003 Budapest Treaty receipt from the American Type Culture Collection. This document acknowledges ATCC's receipt under the Budapest Treaty of a sample of 'Cheniere' seeds on October 23, 2003, and also reports that the sample was viable when tested on October 30, 2003.

It is respectfully submitted that the deposit of 'Cheniere' seeds with ATCC under the Budapest Treaty fully complies with all applicable requirements pertaining to deposits of biological materials, and that this ground of rejection should be withdrawn. In the alternative, should the Office repeat this ground of rejection, then the Office is respectfully requested to clarify the rationale for the rejection, so that a more responsive reply might be made.

The Written Description Rejections

Claims 5 and 10-22 were rejected under 35 U.S.C. § 112, first paragraph as lacking a written description.

Claim 5

The amendment to Claim 5 to delete the word “essentially” overcomes the rationale given for rejecting Claim 5, in a self-evident manner that should not require extended discussion. The amendment to Claim 5 is being made in the hope of accelerating the prosecution of this application. Applicant will elect at a later date whether to pursue the canceled subject matter in a continuation application.

Claims 10-14

Claims 10-14 have been canceled, so further discussion of those Claims is moot. Claims 10-14 have been canceled in the hope of accelerating the prosecution of this application. Applicant will elect at a later date whether to pursue the canceled subject matter in a continuation application.

Claims 15-22

Claims 16-22 all depend from Claim 15. This discussion will therefore focus on Claim 15. Claim 15 has been changed from a product claim to a process claim. The limitations of amended Claim 15 are otherwise similar to those of original Claim 15. Conforming changes have been made to dependent Claims 16-22.

Before the amendment, Claim 15 read as follows:

15. (original) A rice plant derived from the rice plant of Claim 5 by a single gene conversion.

Claim 15 as amended now reads:

15. (currently amended) A method of producing a rice plant, said method comprising deriving a rice plant from the rice plant of Claim 5 by a single gene conversion.

If the undersigned correctly understands the rationale for the written description rejection of Claim 15, then the amendment should overcome the rejection. The Office has not questioned that methods for making single gene conversions are well known in the art, nor that the specification provides an adequate written description for methods of single gene conversion in rice plants. Rather, the Office appears to have objected to whether there is a sufficient description of the resulting plants as compositions of matter. For example, at page 10 the December 16, 2004 Office Action acknowledged that "the introgression of single genes into plants for a desired trait is desirable and is well within the level of one skilled in the art"

See also the specification at paragraphs [0005], [0027], and [0056] - [0058], while keeping in mind that a patent specification should be interpreted as it would be understood by one of ordinary skill in the art. A patent specification need not teach what is already well known in the art.

By analogy, the December 16, 2004 Office Action entered no written description rejection against Claim 9, which is directed to a method for producing hybrid rice seed, while it rejected Claim 10, which is directed to the resulting hybrid rice seed. The same rationale should presumably apply in allowing amended process Claim 15, even though original composition Claim 15 had been rejected.

For the record, Applicant does not agree with the Office's position on written description. However, in the interest of accelerating prosecution, Applicant is conforming these Claims to be consistent with what is understood to be the Office's current practice for inventions pertaining to new plant varieties. Applicant will elect at a later date whether to pursue the canceled subject matter in a continuation application.

Enablement Rejections (other than the one pertaining to the ATCC Deposit)

Claims 5 and 10-22 were rejected under 35 U.S.C. § 112, first paragraph as lacking an enabling description.

Claim 5

The amendment to Claim 5 to delete the word “essentially” overcomes the stated rationale for rejecting Claim 5, in a self-evident manner that should not require extended discussion. This amendment to Claim 5 is being made in the hope of accelerating the prosecution of this application. Applicant will elect at a later date whether to pursue the canceled subject matter in a continuation application.

Claims 10-14

Claims 10-14 have been canceled, so further discussion of those Claims is moot. Claims 10-14 have been canceled in the hope of accelerating the prosecution of this application. Applicant will elect at a later date whether to pursue the canceled subject matter in a continuation application.

Claims 15-22

Claims 16-22 all depend from Claim 15. This discussion will therefore focus on Claim 15. Claim 15 has been changed from a product claim to a process claim. The limitations are otherwise similar. Conforming changes were made to dependent Claims 16-22.

Before the amendment, Claim 15 read as follows:

15. (original) A rice plant derived from the rice plant of Claim 5 by a single gene conversion.

Claim 15 as amended now reads:

15. (currently amended) A method of producing a rice plant, said method comprising deriving a rice plant from the rice plant of Claim 5 by a single gene conversion.

If the undersigned correctly understands the rationale for the enablement rejection of Claim 15, then the amendment should overcome this rejection. The Office has not questioned that methods for making single gene conversions are well known in the art, nor that the specification provides an enabling description of methods for single gene conversions in rice plants. Rather, the Office has objected to enablement of the resulting plants as compositions of matter. For example, at page 10 the December 16, 2004 Office Action acknowledged that "the introgression of single genes into plants for a desired trait is desirable and is well within the level of one skilled in the art"

See also the specification at paragraphs [0005], [0027], and [0056] - [0058], while keeping in mind that a patent specification should be interpreted as it would be understood by one of ordinary skill in the art. A patent specification need not teach what is already well known in the art.

By analogy (and disregarding the biological deposit (ATCC) formality previously discussed), the December 16, 2004 Office Action entered no enablement rejection against Claim 9, which is directed to a method for producing hybrid rice seed, while it rejected Claim 10, which is directed to the resulting hybrid rice seed. The same rationale should presumably apply in allowing amended process Claim 15, even though original composition Claim 15 had been rejected.

For the record, Applicant does not agree with the Office's position on enablement. However, in the interest of accelerating prosecution, Applicant is conforming these Claims to be consistent with what is understood to be the Office's current practice for inventions pertaining to new plant varieties. Applicant will elect at a later date whether to pursue the canceled subject matter in a continuation application.

The § 112, Second Paragraph Rejection

Claim 12 was rejected under 35 U.S.C. § 112, second paragraph, due to a self-evident typographical error. For other reasons, Claim 12 has been now been canceled, making the § 112, second paragraph moot.

The § 102(b) Rejection

Claims 5 and 12-14 were rejected under 35 U.S.C. § 102(b). Claims 12-14 have been canceled.

Claim 5 has been amended to delete the word “essentially.” The December 16, 2004 Office Action at page 13 had observed that deleting the word “essentially” from Claim 5 would overcome the prior art rejection. Accordingly, it is respectfully submitted that the prior art rejection should now be withdrawn.

Applicant notes for the record that the reason for the amendment to Claim 5 was unrelated to the prior art rejection, which could have been overcome by a simple argument without the need for any amendments. Rather, the reason for the amendment to Claim 5 pertained to the § 112, first paragraph rejection, as discussed further above. A “byproduct” of an amendment that was made for reasons pertaining to § 112, first paragraph was that the amendment also happened to be one that the Office has stated (expressly) would overcome the prior art rejection. Likewise, Claims 12-14 were canceled for reasons pertaining to § 112, first paragraph, not prior art. Nothing in the present amendment should be construed as agreement with or acquiescence in any of the Office’s remarks concerning prior art.

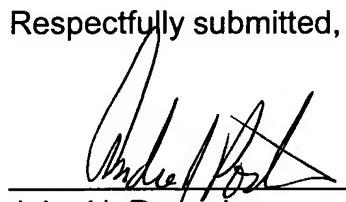
It is respectfully submitted that the § 102(b) rejections should be withdrawn.

Conclusion

Allowance of all pending Claims at an early date is respectfully requested.

In the alternative, should the Examiner identify any remaining issues, the Examiner is respectfully requested to contact the undersigned to schedule a telephone interview before further action is taken, to discuss whether it might be possible to resolve any such issues quickly, and to conclude the prosecution of this application.

Respectfully submitted,



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